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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,557	08/16/2006	Adrian R. Temple-Brown	562492006700	4364
20872 7590 06/08/2009 MORRISON & FOERSTER LLP 425 MARKET STREET SAN FRANCISCO, CA 94105-2482				
EXAMINER				
CHEN, XIAOLIANG				
ART UNIT		PAPER NUMBER		
2841				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/568,557

**Applicant(s)**

TEMPLE-BROWN, ADRIAN R.

**Examiner**

XIAOLIANG CHEN

**Art Unit**

2841

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-8, 10-14, 16-18, 20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-8, 10-14, 16-18, 20 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05-20-09 has been entered.

### ***Amendments***

2. Acknowledgement is made of Amendment filed 05-20-09.
3. Claims 1-4, 11, 14 and 20 are amended.
4. Claims 5, 9, 15, 19 and 21 are canceled.

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1 and 11 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4, 6-8, 11-14, 16-18 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kao et al. (US20030227763) in view of Kocher (US6292004) and Yoshino (US5344341).

**Re Claim 1**, Kao et al. show and disclose

A holder for an electronic module (an apparatus for seating a SIM card [0008]) for connection to a printed circuit board (50, fig. 5) in an electronic equipment (a cell phone [0004]), the holder being configured to receive the electronic module (fig. 6), the holder comprising:

a portion (42, fig. 4A) of the holder,

Kao et al. does not disclose

1) at least one through hole is positioned in the portion to provide access through the holder to the printed circuit board for testing;

2) a conductive layer on a surface of the portion with the at least one hole therethrough for position adjacent the printed circuit board;

Kocher teaches a device wherein

1) at least one through hole (the test fixture has a plurality of test probe holes drilled through it [col. 2, line 10]) is positioned in the portion to provide access through the holder to the printed circuit board for testing (corresponds to the test points on the circuit board to be tested [col. 2, line 12]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the test probe holes as taught by Kocher in the electronic device of Kao et al., in order to test the printed circuit board by the test probe probes. (Kocher, [Abstract])

Yoshino teaches a device wherein

2) a conductive layer on a surface of the portion with the at least one hole therethrough for position adjacent the printed circuit board (conductive film coated on said insulation housing is connected to a ground [Claim 1]);

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to coat a conductive layer as taught by Yoshino for the portion of the holder in the electronic device of Kao et al., in order to provide the electromagnetic shielding against external noise signals to the card holder (Yoshino, col. 1, line 28).

**Re Claim 2,** Kao et al. show and disclose

The holder of claim 1 wherein the at least one hole is positioned to be covered by the electronic module when positioned in the holder (the holes would be covered by the SIM card).

**Re Claim 3,** Kao et al. show and disclose

The holder of claim 1 wherein the holder includes a plurality of holes (a plurality of test probe holes, see claim 1) therethrough.

**Re Claim 4,** Kao et al. show and disclose

The holder of claim 1 wherein the holder is configured to be mounted on the printed circuitry board by one of the group consisting of: surface mount technology (the holder is mounted on the printed circuitry board by the surface mount leads or pads, fig. 3) and plated through hole technology.

**Re Claim 6,** Kao et al. show and disclose

The holder of claim 1 wherein the electronic module comprises a subscriber identification module (SIM card [0002]).

**Re Claim 7,** Kao et al. show and disclose

The holder of claim 1 wherein the electronic equipment comprises wireless communication equipment (a cell phone [0004]).

**Re Claim 8,** Kao et al. show and disclose

The holder of claim 7 wherein the wireless communication equipment comprises a portable modem (SIM card [0002]).

**Re Claim 11,** Kao et al. show and disclose

A method of assembling a holder for an electronic module on a printed circuit board in an electronic equipment, the method comprising:

providing the printed circuit board (50, fig. 5);

providing a holder for the electronic module (an apparatus for seating a SIM card [0008]) for mounting to the printed circuit board (fig. 5), the holder being configured to receive the electronic module (fig. 6) and having a portion (42, fig. 6) of the holder;

mounting the holder on the printed circuit board (fig. 5).

Kao et al. does not disclose

1) at least one hole is positioned in the portion to provide access through the holder to the printed circuit board for testing purposes;

2) providing a conductive layer on a surface of the portion with the at least one hole for positioning adjacent the printed circuit board;

Kocher teaches a device wherein

1) at least one hole (the test fixture has a plurality of test probe holes drilled through it [col. 2, line 10]) is positioned in the portion to provide access through the holder to the printed circuit board for testing purposes (corresponds to the test points on the circuit board to be tested [col. 2, line 12]);

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the test probe holes as taught by Kocher in the electronic device of Kao et al., in order to test the printed circuit board by the test probe probes. (Kocher, [Abstract])

Yoshino teaches a device wherein

2) providing a conductive layer on a surface of the portion with the at least one hole for positioning adjacent the printed circuit board (conductive film coated on said insulation housing is connected to a ground [Claim 1]);

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to coat a conductive layer as taught by Yoshino for the portion of the holder in the electronic device of Kao et al., in order

to provide the electromagnetic shielding against external noise signals to the card holder (Yoshino, col. 1, line 28).

**Re Claim 12**, Kao et al. show and disclose

The method of claim 11 further comprising inserting the electronic module (insertion of the SIM card [0004]) in the holder such that the at least one hole is covered by the electronic module (fig. 7).

**Re Claim 13**, Kao et al. show and disclose

The method of claim 11 wherein the holder is provided with a plurality of holes (a plurality of test probe holes, see claim 11) therethrough.

**Re Claim 14**, Kao et al. show and disclose

The method of claim 11 wherein mounting comprises mounting the electronic module on the printed circuit board by one of the group consisting of: surface mount technology (the holder is mounted on the printed circuitry board by the surface mount leads or pads, fig. 3); and plated through hole technology.

**Re Claim 16**, Kao et al. show and disclose

The method of claim 11 wherein the electronic module comprises a subscriber identification module (SIM card [0002]).

**Re Claim 17**, Kao et al. show and disclose

The method of claim 11 wherein the electronic equipment comprises wireless communication equipment (a cell phone [0004]).

**Re Claim 18**, Kao et al. show and disclose



The method of claim 17 wherein the wireless communication equipment comprises a portable modem (SIM card [0002]).

**Re Claim 22**, Kao et al. show and disclose

An electronic circuit (23, fig. 6) having mounted on the holder of claim 1.

8. Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kao et al. in view of Kocher and Yoshino as applied to claims 1 and 11 above, and further in view of Kaneshige et al. (US5655917).

**Re Claims 10 and 20**, Kao et al., Kocher and Yoshino disclose

According to claims 1 and 11 respectively,

Kao et al., Kocher and Yoshino do not disclose

wherein the holder is of moulded plastics material.

Kaneshige et al. teaches a device wherein

the holder is of moulded plastics material. (The frame of the card holder is molded of plastic material [col. 2, line 8]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the moulded plastics material as taught by Kaneshige et al. for the card holder of Kao et al., in order to reduce the cost of the electronic device.

**Conclusion**

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US-20030020149 US-20020006751 US20010010983 US-5823828 US-4749943 US-6609936 US-6382995 US-6544074.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to XIAOLIANG CHEN whose telephone number is (571)272-9079. The examiner can normally be reached on 7:00-5:00 (EST), Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on 571-272-2800, ext 31. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dean A. Reichard/

Xiaoliang Chen

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Supervisory Patent Examiner, Art Unit 2841

Examiner  
Art Unit 2841